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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,699	02/01/2001	Ichiro Fujita	1614.1122	3086
21171	7590	03/13/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PORTER, RACHEL L	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/774,699

Applicant(s)

FUJITA, ICHIRO

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 12/15/05. Claims 5-12 are pending. Claims 1-4 and 13-15 have been canceled.

Drawings

2. The drawing received on 12/15/05 is acknowledged. This drawing is not acceptable.

Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "**Replacement Sheet**" or "**New Sheet**" pursuant to 37 CFR 1.121(d).

The replacement drawing with the corrections (Figure 1) should be resubmitted and labeled as a "Replacement Sheet."

The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

3. The rejection of claims 1-11 under 35 U.S.C. 101 is hereby withdrawn.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-6 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (USPN 6,347,302) in view of Solomon et al (USPN 6,847,935).

[claim 5] Joao a system for mediating the transmission of information among users via a network, said system comprising:

- a first computer storage part in which purchase information related to products possessed by said at least one user is stored; (col. 2, lines 33-49; col. 5, line 59-col. 6, line 6; lines 50-57)
- an insurance request part which requests insurance on said products according to said purchase information stored in a first computer storage part. (col. 8, lines 41-61)

Joao teaches a system which includes a first storage stores purchase related information on products possessed by the user and also includes an insurance request component as explained above. However, Joao does not expressly disclose a second storage component with an identifier and guarantee related information from at least one manufacturer for each product to be insured. Solomon discloses a system, which stores identifier and guarantee (i.e. warranty) for multiple manufacturer products. (col. 6, lines 3-35; lines 51-57) The storage component includes transaction codes/ UPC's/ SKU's/ product descriptions (i.e. manufacturer product identifiers) and information on warranties. Solomon further discloses that the system may retrieve the information stored in the (second) storage component and allows insurance requests on products

according to purchase information stored in the (second) storage component. (Figure 9, col. 10, lines 26-45—e.g. verification of information transaction/purchase by accessing transaction table) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Joao with the teaching of Solomon to store the recited data and to provide insurance request part which request insurance based upon purchase data found in the first and second storage components. As suggested by Solomon, one would have been motivated to include these features to capture a more exhaustive list of information, providing a greater opportunity for data mining (Solomon: col. 2, lines 17-20) and to allow the information in the one source to "verify" the information in the second source. (col. 1, lines 62-col. 2, line 8)

[claim 6] Joao and Solomon teach the system as claimed in claim 5 as explained in the rejection of claim 5. Furthermore, Joao teaches a system wherein said insurance request part sends information includes at least maintenance of the product (col. 9, lines 15-40).

[claim 9] Joao teaches a computer system for managing information transfer over a network among a plurality of users, said system comprising:

- a first computer storage part in which purchase information related to products possessed by said at least one user is stored; and (col. 2, lines 33-49; col. 5, line 59-col. 6, line 6; lines 50-57)

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- an insurance request part capable of sending requests to said at least one insurer for making an insurance contract on said products according to said purchase information stored in the first computer storage part. (col. 8, lines 41-61)

Joao teaches a system which includes a first storage stores purchase related information on products possessed by the user and also includes an insurance request component as explained above. However, Joao does not expressly disclose a second storage component with an identifier and guarantee related information from at least one manufacturer for each product to be insured. Solomon discloses a system, which stores identifier and guarantee (i.e. warranty) for multiple manufacturer products. (col. 6, lines 3-35; lines 51-57) The storage component includes transaction codes/ UPC's/ SKU's/ product descriptions (i.e. manufacturer product identifiers) and information on warranties. Solomon further discloses that the system may retrieve the information stored in the (second) storage component and allows insurance requests to be sent for products according to purchase information stored in the (second) storage component. (Figure 9, col. 10, lines 26-45—e.g. verification of information transaction/purchase by accessing transaction table) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Joao with the teaching of Solomon to store the recited data and to provide insurance request part which request insurance based upon purchase data found in the first and second storage components. As suggested by Solomon, one would have been motivated to include these features to capture a more exhaustive list of information, (Solomon: col. 2,

lines 17-20) and to allow the information in the one source to “verify” the information in the second source. (col. 1, lines 62-col. 2, line 8)

[claim 10] Joao teaches a method of mediating between users over a network, said method comprising:

- receiving purchase information related to products possessed by said at least one user; (col. 5, lines 38-58; col. 9, lines 16-42)
- storing said purchase information in a first computer storage part; and (col. 9, lines 16-42)
- requesting insurance on said products according to said purchase information stored in a first computer storage part. (col. 9, lines 26-col. 10, lines 24)

Joao teaches a system which includes a first storage stores purchase related information on products possessed by the user and also includes an insurance request component as explained above. However, Joao does not expressly disclose a second storage component with an identifier and guarantee related information from at least one manufacturer for each product to be insured. Solomon discloses a system, which stores identifier and guarantee (i.e. warranty) for multiple manufacturer products. (col. 6, lines 3-35; lines 51-57) The storage component includes transaction codes/ UPC's/ SKU's/ product descriptions (i.e. manufacturer product identifiers) and information on warranties. Solomon further discloses that the system may retrieve the information stored in the (second) storage component and allows insurance requests on products according to purchase information stored in the (second) storage component. (Figure 9,

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col. 10, lines 26-45—e.g. verification of information transaction/purchase by accessing transaction table) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Joao with the teaching of Solomon to store the recited data and to provide insurance request part which request insurance based upon purchase data found in the first and second storage components. As suggested by Solomon, one would have been motivated to include these features to capture a more exhaustive list of information, providing a greater opportunity for data mining (Solomon: col. 2, lines 17-20) and to allow the information in the one source to "verify" the information in the second source. (col. 1, lines 62-col. 2, line 8)

[claim 11] Joao teaches a method of managing information transfer over a network among users, said method comprising :

- receiving purchase information related to products possessed by said at least one user; (col. 5, lines 38-58; col. 9, lines 16-42)
- storing said purchase information in a first storage part; (col. 9, lines 16-42)
- sending requests to said at least one insurer for making an insurance contract on said products according to said purchase information stored in a first computer storage part. (col. 9, lines 26-col. 10, lines 24)

Joao teaches a system which includes a first storage stores purchase related information on products possessed by the user and also includes an insurance request component as explained above. However, Joao does not expressly disclose a second storage component with an identifier and guarantee related information from at least

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one manufacturer for each product to be insured. Solomon discloses a system, which stores identifier and guarantee (i.e. warranty) for multiple manufacturer products. (col. 6, lines 3-35; lines 51-57) The storage component includes transaction codes/ UPC's/ SKU's/ product descriptions (i.e. manufacturer product identifiers) and information on warranties. Solomon further discloses that the system may retrieve the information stored in the (second) storage component and allows insurance requests to be sent for products according to purchase information stored in the (second) storage component. (Figure 9, col. 10, lines 26-45—e.g. verification of information transaction/purchase by accessing transaction table) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Joao with the teaching of Solomon to store the recited data and to provide insurance request part which request insurance based upon purchase data found in the first and second storage components. As suggested by Solomon, one would have been motivated to include these features to capture a more exhaustive list of information, (Solomon: col. 2, lines 17-20) and to allow the information in the one source to "verify" the information in the second source. (col. 1, lines 62-col. 2, line 8)

[claim 12] Claim 12 repeats the subject matter of claim 10 a computer readable medium storing instructions, which cause a computer to perform the underlying method, recited in claim 10. As the underlying process has been shown to be fully disclosed and computer implemented by the teachings of Joao in the above rejection of claim 10, it is readily apparent that the Joao reference includes computer readable medium with

instructions to cause a computer to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claim 10 and incorporated herein.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao and Solomon as applied to claim 5, and further in view of Official Notice.

[claim 7] Joao teaches a system for insuring gathering and exchanging information on products from a user and submitting a request for insurance for the products (col. 9, lines 26-col. 10, lines 24), but does not expressly disclose that the insurance request part sends information for collectively insuring a plurality of products with a single insurance contract. However, it is respectfully submitted that it is old and well known in the insurance art to carry multiple coverages on a single contract or to insure more than one item on a single contract. For example, automobile owners who have multiple cars will often place all cars on a single policy. At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teaching of Joao to allow the user to insure multiple products with a single insurance contract. One would have been motivated to include this feature to streamline the process of insuring the products.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao and Solomon as applied to claim 5 above, and further in view of Lockwood.

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[claim 8] Joao and Solomon teach the system of claim 5 as explained in the rejection of claim 5. Joao further discloses a system that provides insurance quotes and contracts for a product as requested by a user and based upon stored data (col. 9, lines 44-col. 10, line 35), but does not expressly disclose gathering insurance estimates from a plurality of insurers. Lockwood teaches a system which receives estimates from a plurality of insurers and which prepares a contract for insurance with the selected insurer. (col. 2, lines 8-19; col. 5, lines 44-col. 6, line 32) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Joao and Solomon in combination with the teaching of Lockwood to include gather estimates from a plurality of insurers and to prepare a contract for insurance with the selected insurer. As suggested by Lockwood, one would have been motivated to include these features to allow the prospective insured to quotations from various institutions quickly and easily, and to compare quotations at leisure or obtain a policy on the spot. (col. 3, lines 33-37)

Response to Arguments

8. Applicant's arguments filed 12/15/05 have been fully considered but they are not persuasive.

(A) Applicant argues the new limitations of claims 9-12. However, these limitations have been addressed by a new art limitation provided in the current Office Action.

(B) Applicant argues that the combination of Joao and Solomon is improper because Solomon is non-analogous art.

In response to applicant's argument that Solomon is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Solomon reference has been relied upon to teach the storage of specific purchase data that may also be provided/retrieved when sending requesting for product insurance (e.g. warranty). Similarly, the Joao reference stores specific purchase information regarding items for which an insurance product is sought. Thus, it is respectfully submitted that both the Joao and Solomon references are pertinent to the applicant's field of endeavor.

In response to applicant's argument that the "recited second computer is provided for requesting insurance information on products *regardless if the user knows detailed information about the product they wish to purchase*", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Moreover, the claim language does not clearly recite that the data in the two storage parts are complementary or that data lacking in one source is supplemented by data in the other.

(C) Applicant has challenged Examiners use of Official Notice in the Rejection of claim 7.

It should be noted that in order to adequately traverse the Examiner's use of Official Notice MPEP §2144.03 (C) also provides the following guidance:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include **stating why the noticed fact is not considered to be common knowledge or well-known in the art**. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate.

Examiner noted in the rejection of claim 7 that it is old and well known in the insurance art to carry multiple coverages on a single contract or to insure more than one item on a single contract. As an example the Examiner explained that automobile owners who have multiple cars will often place all cars on a single policy. It is respectfully submitted the Applicant has not provided any explanation or statement as to why the noted fact is not considered to be common knowledge or well-known in the art.

Furthermore, McMillan et al (USPN 5,797,134) discloses that a single insurance contract for a product (automobile insurance) may carry multiple coverages (e.g. liability, comprehensive, liability, collision.) (col. 2, lines 1-14)

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Maxwell et al (USPN 5,675,784) discloses a system and method for storing product information including warranty information.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

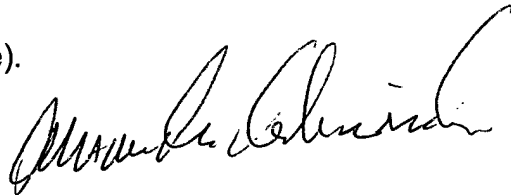
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



RP

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